



10/500983

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:)
Philippe BRESSY et al) Group Art Unit: Not yet assigned
Serial No. 10/500,983) Examiner: Not Yet Assigned.
International Appln. No. PCT/EP03/00075
International Filing Date: January 7, 2003
Filed: July 6, 2004)
For: PROTECTING A DEVICE AGAINST)
UNINTENDED USE IN A SECURE)
ENVIRONMENT)

*dec file w/
attached notatn*

RECEIVED

10 NOV 2004

Legal Staff
International Division

PETITION UNDER 37 CFR 1.47(a)

It is respectfully requested that the above-captioned application be accepted for filing based upon a Declaration and Power of Attorney, submitted herewith, signed by one of the two inventors, for the reason that the non-signing inventor has refused to sign the Declaration. This Petition sets forth and includes proof of the applicable facts, transmits the requisite petition fee under 37 CFR 1.17(h) and provides the last known mailing address of the non-signing inventor.

Applicant inventor Yann LOISEL submits herewith the Declaration of Virginie Delemotte ("Delemotte Declaration") and attached Exhibits A, B, C and D to prove the applicable facts. Ms. Delemotte is the Patent Manager for SCM Microsystems GmbH (Delemotte Declaration, Paragraph 1), the employer of Yann LOISEL and the former employer of the non-signing inventor, Philippe BRESSY. In her capacity as Patent Manager she is responsible for filing patent applications around the world for SCM Microsystems GmbH. The instant application is a U.S. national stage application based upon PCT/EP03/00075 which claims the priority of prior German Application No. 102 00 288.6, filed January 7, 2002. The PCT application has been published as International Publication No. WO 03/058409 A2 (Delemotte Declaration, Paragraph 2). Ms. Delemotte obtained the signature of inventor Yann LOISEL to a Declaration and Power of Attorney which is submitted herewith and is attached to the Declaration as Exhibit A (Delemotte Declaration, Paragraphs 3 and 4). She forwarded, via letter to inventor Philippe BRESSY, on August 9, 2004, copies of the Declaration and Power of

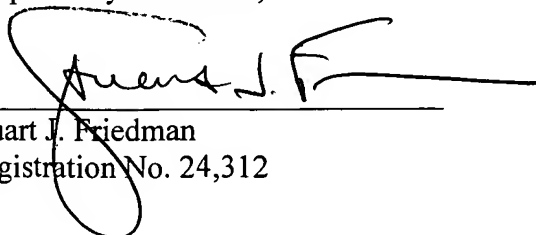
Attorney and requested that he sign the Declaration and Power of Attorney (Delemotte Declaration, Paragraph 5). In a subsequent e-mail exchange between Ms. Delemotte and Mr. BRESSY, he refused to sign the Declaration and Power of Attorney unless he was paid certain sums of money which he was demanding (Delemotte Declaration, Paragraph 6 and Exhibit B). Subsequently, Ms. Delemotte forwarded, via registered letter, to inventor Philippe BRESSY, on September 27, 2004, copies of the Declaration and Power of Attorney and application papers and requested that he sign the Declaration and Power of Attorney and return it by October 15, 2004. This September 27, 2004 letter was identical to the prior August 9, 2004 letter except that it also enclosed copies of the application papers. The registered letter and an English language translation thereof are attached to the Declaration as Exhibit C (Delemotte Declaration, Paragraph 7). On October 14, 2004, there was another e-mail exchange between Ms. Delemotte and Mr. BRESSY during which he reiterated his refusal to sign the Declaration and Power of Attorney unless he was paid monies to which he was not entitled (Delemotte Declaration, Paragraph 8 and Exhibit D).

The last known mailing address of inventor Philippe BRESSY is 8 Rue du Lancon, 83190 Ollioules, FRANCE (Delemotte Declaration, Paragraph 9). ✓

The required petition fee of \$130 under 37 CFR 1.17(h) is submitted herewith. ✓

It is respectfully requested that this Petition be granted and the above-captioned application be accepted for filing pursuant to 37 CFR 1.47(a).

Respectfully submitted,


Stuart J. Friedman
Registration No. 24,312

Law Offices of Stuart J. Friedman
28930 Ridge Road
Mt. Airy, MD 21771
Telephone: (301) 829-1003
Facsimile: (301) 829-4107



- 1 -

Docket: 740612-186

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:)
Philippe BRESSY et al) Group Art Unit: Not yet assigned
Serial No. 10/500,983) Examiner: Not Yet Assigned.
International Appln. No. PCT/EP03/00075
International Filing Date: January 7, 2003
Filed: July 6, 2004)
For: PROTECTING A DEVICE AGAINST)
UNINTENDED USE IN A SECURE)
ENVIRONMENT

DECLARATION OF VIRGINIE DELEMOTTE

VIRGINIE DELEMOTTE declares as follows:

1. I am employed by SCM Microsystems GmbH as Patent Manager and have a mailing address of ZE Athélia II-n° 216, avenue du Serpolet, F-13704 LA CIOTAT, Cedex, FRANCE.
2. As Patent Manager, I am responsible for filing applications owned by SCM Microsystems GmbH around the world, including the United States. In accordance with this responsibility I arranged for an application entitled PROTECTING A DEVICE AGAINST UNINTENDED USE IN A SECURE ENVIRONMENT, based upon PCT/EP03/00075, published as WO 03/058409 A2, claiming priority from German Patent Application 102 00 288.6, filed January 7, 2002, to be filed in the United States Patent and Trademark Office on July 6, 2004 naming as inventors Philippe BRESSY and Yann LOISEL, the very same inventors identified in the PCT patent application.
3. I arranged for the Declaration and Power of Attorney to be signed by one of the inventors, Yann LOISEL. However, when I forwarded the patent application to the other inventor, Philippe BRESSY, who is no longer an employee of SCM

Docket No.: 740612-186
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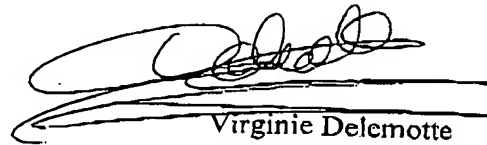
Microsystems GmbH, he refused to sign the Declaration and Power of Attorney unless he was paid monies to which he is not entitled.

4. A copy of the Declaration and Power of Attorney signed by Yann LOISEL is attached hereto as Exhibit A.
5. A letter was sent by me to Philippe BRESSY on August 9, 2004 enclosing a copy of a Declaration and Power of Attorney and an Assignment and requesting that he sign the Declaration and Assignment.
6. E-mail correspondence between myself and Philippe BRESSY followed in which he demanded certain payments, to which SCM Microsystems GmbH did not believe he was entitled, and refused to sign the documents. Copies of the e-mail correspondence and English language translations thereof are attached hereto as Exhibit B.
7. Subsequently, a registered letter with confirmation of delivery was sent by me to Philippe BRESSY on September 27, 2004, which was the identical letter sent on August 9, 2004 except that this letter enclosed copies of the application as well as the Declaration and Power of Attorney and Assignment. It requested that he sign the Declaration and Assignment and return the signed documents by October 15, 2004. A copy of that letter and an English language translation thereof are attached hereto as Exhibit C.
8. On October 14, 2004, there was a further e-mail exchange between myself and Philippe BRESSY during which he reiterated his refusal to sign unless he was paid monies to which he is not entitled. Copies of this e-mail correspondence and English language translations thereof are attached hereto as Exhibit D.
9. The current mailing address of Philippe BRESSY is 8 Rue du Lancon, 83190 Ollioules, FRANCE.

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10. The undersigned being duly warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

October 21, 2004
Date


Virginie Delemotte

BEST AVAILABLE COPY

DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN
APPLICATION DATA SHEET (37 CFR 1.76) AND POWER OF ATTORNEYTitle of Invention **PROTECTING A DEVICE AGAINST UNINTENDED USE IN A SECURE ENVIRONMENT**

As the below named inventor(s), I/we declare that:

This declaration is directed to:

- ☐ The attached application, or
☒ Application No. 10/500,983, filed on July 6, 2004,
☐ as amended on _____ (if applicable);

I/We believe that I/we am/are the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought;

I/We have reviewed and understand the contents of the above-identified application, including the claims, as amended by any amendment specifically referred to above;

I/We acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me/us to be material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT International filing date of the continuation-in-part application.

All statements made herein of my/own knowledge are true, all statements made herein on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and may jeopardize the validity of the application or any patent issuing thereon.

I/We hereby appoint:

Practitioners at Customer Number 41972 as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith.

FULL NAME OF INVENTOR(S)

Inventor one: Philippe BRESSYSignature: _____ Citizen of: FranceInventor two: Yann LOISELSignature:  _____ Citizen of: France

Inventor three: _____

Signature: _____ Citizen of: _____

Inventor four: _____

Signature: _____ Citizen of: _____

☐ Additional inventors are being named on _____ additional form(s) attached hereto.

APPLICATION DATA SHEET

Electronic Version v14

Stylesheet Version v14.0

Title of Invention	Protecting a Device Against Unintended Use in a Secure Environment		
Application Type: regular, utility Attorney Docket Number: 740612-186			
Correspondence address: Customer Number: 41972 *41972*			
Continuing Data: This is a National Stage of WO application number PCT/EP03/00075, filed 2003-01-07 , now Pending.			
Priority Data: Doc.No: 102 00 288.6; Country - DE; Date: 2002-01-07 us-priority-claimed			
Inventors Information: <u>Inventor 1:</u> Applicant Authority Type: Inventor Citizenship: FR Given Name: Philippe Family Name: BRESSY City of Residence: Ollioules Country of Residence: FR Address-1 of Mailing Address: 8, rue du Lancon Address-2 of Mailing Address: City of Mailing Address: Ollioules State of Mailing Address: Postal Code of Mailing Address: F-83190 Country of Mailing Address: FR			

Phone:

Fax:

E-mail:

Inventor 2:

Applicant Authority Type: Inventor

Citizenship: FR

Given Name: Yann

Family Name: LOISEL

City of Residence: La Ciotat

Country of Residence: FR

Address-1 of Mailing Address: Lotissement Le Revestin

Address-2 of Mailing Address: Chemin des Severiers

City of Mailing Address: La Ciotat

State of Mailing Address:

Postal Code of Mailing Address: F-13600

Country of Mailing Address: FR

Phone:

Fax:

E-mail:

Publication Information:

Suggested Figure for Publication - Figure 1

Suggested Classification -

Suggested Technology Center -

Total Number of Drawing Sheets -

Assignee 1:

Organization Name: SCM Microsystems GmbH

Address-1 of Mailing Address: Oskar-Messter-Strasse 13

Address-2 of Mailing Address:

City of Mailing Address: Ismaning

State of Mailing Address:

Postal Code of Mailing Address: 85737

Country of Mailing Address: DE

Phone:

Fax:

E-mail:

Bon,

Je reprend différemment,

Déplacement Poste pour récupérer le Recommandé avec A/R	1 heure
Echanges par Emails sur le Sujet	1 heure
Forfait Frais d'envoi	50 EUR

Taux Horaire HT 350EUR
Soit un total de

750 EUR HT

Voilà,

a++

ydelemotte@scmmicro.fr wrote:

Philippe
SCM ne s'est pas engagé à payer des primes brevets aux inventeurs ayant quittés la société.
SCM t'a payé la prime de dépôt parce que tu étais dans la société quand on a déposé le brevet. La prime de délivrance de brevet ne peut être payée que si le brevet est accordé (ce qui n'est pas le cas) et si l'inventeur est toujours dans la société.
Je te rapelle qu'il n'y a pas d'obligation légale à payer des primes brevets aux ingénieurs R&D en France sauf si le brevet rapportait de façon exceptionnel à SCM. Nous n'en sommes pas encore à ce stade puisqu'on ne sait pas encore si le brevet est accordé.

Tu as signé pour le dépôt en Allemagne un document en Français s'appelant "cession d'un intérêt entier dans une invention" voir document ci-joint.
Tu ne peux pas t'opposer à la signature du document envoyé qui est destiné au dépôt aux USA, puisque dans le document de cession tu t'engages à signer tous les documents nécessaires dans le futur et relatifs à l'invention.
(See attached file: assignment cession in french for french inventors PB 4764.xls)

Best regards

Virginie Delemotte
Patent Manager
SCM Microsystems

Web:

<http://www.scmmicro.com>

ZE Athélie II - n° 216, avenue du Serpolet

Tel. :

+33 (0)4 42 83 82 60

F-13704 LA CIOTAT Cedex

(0)4

42 83 85 24

Fax. :+33

This email message is attorney - client privileged and may contain confidential information

Philippe Bressy

<philippe.bressy@
vdelemotte@scmmicro.fr
free.fr>

To:

cc:

Subject: 4764 secure

architecture, pouvoirs à signer
26/08/2004 11:01

Salut Virginie,

Non, je n'ai pas renvoyé les papiers et je n'ai pas l'intention de les envoyer sans contre partie.

Mon avocat me demande des frais de traduction pour pouvoir statuer en engageant sa responsabilité.
Et, comme je n'ai pas l'intention de payer quoi que ce soit ...

Je te rappelle le problème,
SCM ne veut pas assumer ses engagements sur le paiement de la prime brevet, parce que je ne suis plus dans la société.
Mon avocat me dit rapidement, que sans contre partie, je n'ai aucun engagement à tenir.
Encore pire, il me pousse à négocier à la hausse ma signature, en me disant que ne faisant plus parti du personnel SCM, les tarifs deviennent libres.
Pour finir, que tous les papiers m'engageant doivent être rédigés en Français, où faire l'objet d'une traduction.

a++
Philippe

vdelemotte@scmmicro.fr wrote:

Bonjour Philippe,
as-tu renvoyé les papiers signés à SCM ?
merci
Best regards

Virginie Delemotte
Patent Manager
SCM Microsystems
<http://www.scmmicro.com> Web:
ZE Athélia II - n° 216, avenue du Serpolet
Tel. :
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F-13704 LA CIOTAT Cedex
Fax. :+33 (0)4
42 83 80 01

This email message is attorney - client privileged and may contain confidential information

Translation of the e-mails

Well,

I start differently,

Travelling costs to the post office to pick up the registered letter with

Advice of delivery: 1 hour

Correspondence via e-mail on this subject 1 hour

Lump sum for forwarding expenses 50 EUR

Hourly rate of pay 350 EUR

Total amount of 750 EUR

That's it,

a++

Virginie Delemotte wrote:

Philippe,

SCM has not committed itself to pay patent awards to inventors who have left the company. SCM paid you the application award because you were a staff member of the company at the time we filed the patent. The award of grant can be paid only if the patent is granted (which is not the case) and if the inventor is still a staff member of the company.

Please remember that there is no legal obligation to pay patent awards to the R&D engineers in France, except if due to this patent, SCM earned an exceptional amount of money. We are not yet at this point since we do not know if the patent is granted.

You have signed for the application in Germany a French document called "cession d'un intérêt entier dans une invention" (assignment of an entire right in and to an invention), see enclosed document. You can not refuse to sign the document sent which is for the application in the USA because in the assignment document you commit yourself to sign all documents necessary in the future and concerning the invention. (see attached file: assignment cession in French for French inventors PB 4764.xls)

Best regards

Virginie Delemotte

Patent Manager

SCM Microsystems

Philippe Bressy wrote:

Dear Virginie,

No, I have not returned the papers and I do not intend to send them without any compensation.

My lawyer asks for translation fees to be able to decide and assume personal responsibility.

As I do not intend to pay anything...

I remind you of the problem,

SCM does not want to take on its responsibility concerning the payment of the patent award because I am not in the company anymore.

My lawyer tells me quickly that without any compensation I am not committed to anything.

Even worse, he pressed me to negotiate my signature to a higher price, telling me that as I am not a member of the staff of SCM anymore, the fees become free.

Finally, all papers which put me under an obligation have to be written in the French language or have to be translated.

a++

Philippe

Virginie Delemotte wrote:

Hello Philippe,

have you returned the signed papers to SCM?

Thank you.

Best regards

Virginie Delemotte
Patent Manager
SCM Microsystems

Siège Européen ;
SCM Microsystems GmbH
Spert-Ring4 - Hettenshausen
D-85276 Pfaffenhofen
Tel : (49) 8441 8 96 0
Fax : (49) 8441 896 111

SCM Microsystems
ZE Athélia II
216, avenue du Serpolet
F - 13704 La Ciotat Cedex
Tel : (33) 4 42 83 80 00
Fax : (33) 4 42 83 80 01

SCM
MICROSYSTEMS

Philippe Bressy
8 Rue du Lançon,
83190 Ollioules,
France

A l'attention de Philippe Bressy

SCM Microsystems, le 27/09/04

LETTRE RECOMMANDEE AVEC ACCUSE DE RECEPTION

Objet : signature du document « assignment » pour demande de brevet secured architecture aux Etats Unis

Monsieur,

Vous avez été désigné en tant qu'inventeur pour le brevet Secured architecture PCT/EP03/00075 qui a été étendu aux Etats Unis (voir copie du texte de dépôt ci-joint).

Pour des formalités de procédures, essentiellement aux Etats-Unis, nous avons besoin de fournir des documents signés par les inventeurs. Ces documents sont impératifs selon la loi américaine.

Nous vous remercions de bien vouloir signer les documents ci-joint « assignment » et « declaration for utility ... » qui sont nécessaire pour poursuivre les démarches relatives à ce brevet. Nous vous prions de bien vouloir nous retourner les documents ci-joint signés avant le 15 Octobre 2004.

Vous en remerciant par avance, nous vous prions d'agréer, Monsieur, l'expression de nos sentiments distingués.

Virginie Delemotte
Patent Manager

PJ :
Assignment
Declaration for utility
Brevet tel que depose aux USA

SCM Microsystems to Philippe Bressy, 27 September 2004

REGISTERED LETTER WITH ADVICE OF DELIVERY

Re: Signature of the "assignment" document for secured architecture patent application in the USA

Dear Mr. Bressy,

You have been designated as inventor for the Secured architecture patent PCT/EP03/00075, which has been extended to the USA (see enclosed copy of the application text).

For reasons of formal requirements in the procedure, especially in the USA, we need to submit documents signed by the inventors. According to American law, these documents are imperative.

We thank you for signing the enclosed "assignment" and "declaration for utility..." documents which are required to proceed with the steps concerning this patent. We kindly ask you to sign and return the enclosed documents prior to October 15, 2004.

Best regards

Virginie Delemotte
Patent Manager

Enclosures:
Assignment
Declaration for utility
Patent as filed in the USA

vdelemotte@scmmicro.fr wrote:

Philippe

tu as la possibilité de revoir le texte correspondant puisqu'il est

joint

au courrier du 27 septembre.

L'extension aux US et en Europe a eut lieu en Juillet 2004

puisque'on

a pris

la voie du PCT et donc que ça repousse le délai de 18 mois.

La déclaration n'établit pas que tu étais SCM en Juillet 2004.

Je note bien que tu refuses de signer cette déclaration

Best regards

Virginie Delemotte

Patent Manager

SCM Microsystems

14/oct/2004 9:15 V. Delemotte -> P. Bressy

subject : "declaration for utility" document explanation

Philippe,

you have the possibility to review the text as it is attached to my mail

dated September 27.

The extension to the US & EP has been done on July 2004 as we take the option of the PCT and then the deadline is delayed by 18 months.

I note that you refuse to sign the declaration

Virginie,

J'ai effectivement la possibilité de revoir le document correspondant. Mais, cela implique du travail (relecture), donc une rétribution. Ne pas faire cette relecture, est équivalent à signer un 'faux'.

Il y a donc deux possibilités:

- Soit SCM paye le travail correspondant,
- Soit SCM établit une attestation/décharge sur le fait que je n'ai pas relu les documents signés,

Et je te réexplique encore une fois, que je ne refuse pas de signer cette déclaration.

En attirant toute ton attention sur le fait que sans évolution rapide de la position de SCM, je ne serai pas en mesure de retourner les documents signés avant le 15/10/2004. (demain)

Sincères salutations
Philippe Bressy

14/oct/2004 9:48 P. Bressy -> V. Delemotte
subject : "declaration for utility" document explanation
Virginie

Indeed I may review the corresponding document.
But, It requires work(reading) and then money.
To not do this work is as to sign a false declaration.
There is then 2 possibilities :
- either SCM pay the work
- or SCM establishes a document discharging myself on his responsibilities
linked by the reading of the documents.

And I explain again that I did not refuse to sign the declaration. And I bring your attention on the fact that if the situation do not move quickly on the SCM side, I will not be able to return the documents signed by oct 15, 2004(tomorrow).

regards
Philippe Bressy.